

Attorney Docket No.: A32359-A 070050.1462

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Modak et al.

Serial No. : 09/777,121 Examiner : Kennedy, Sharon E.

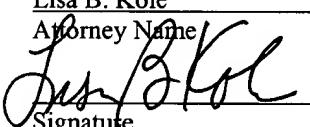
Filed : February 5, 2001 Group Art Unit : 3762

For : TRICLOSAN AND SILVER COMPOUND CONTAINING MEDICAL DEVICES

**TERMINAL DISCLAIMER**

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to:  
Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.

August 20, 2004  
Date of Deposit

Lisa B. Kole  
Attorney Name  
  
Signature

35,225  
Registration No.

August 20, 2004  
Date of Signature

**Mail Stop Petition**  
Commissioner for Patents  
Box 1450  
Alexandria, VA 22313-1450

Sir:

The Trustees of Columbia University in the City of New York, the owner of the entire interest in U.S. Application Serial No. 09/771,121, filed on February 5, 2001 for "TRICLOSAN AND SILVER COMPOUND CONTAINING MEDICAL DEVICES," as evidenced by an assignment to The Trustees of Columbia University in the City of New York, submitted to the Patent Office on June 30, 2004 and attached hereto as Exhibit A, hereby disclaims the terminal part of the statutory term of any patent granted on the above-identified application, which would

08/24/2004 SSITHIB1 00000044 09777121  
02 FC:1814  
110.00 op

extend beyond the expiration date of the full statutory term, defined in 35 U.S.C. § 154 to 156 and 173, of commonly owned issued U.S. Patent No. 6,224,579. A copy of the assignment of U.S. Patent 6,224,599, recorded by the Patent Office at Reel/Frame 14852/0785 on July 15, 2004, is attached as Exhibit B. The owner hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that it and granted U.S. Patent No. 6,224,579 are commonly owned. This agreement shall run with any patent granted on the instant application and shall be binding upon the assignees, their successors, or assigns.

The undersigned is an attorney of record and has the authority to execute this Terminal Disclaimer on behalf of The Trustees of Columbia University in the City of New York, and has reviewed the above-referenced assignments and hereby certifies that, to the best of my knowledge and belief, title is in the assignees on whose behalf this terminal disclaimer is being filed.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Pursuant to 37 C.F.R. §1.20 (d), a check is enclosed in the amount of \$110.00. Should any additional fees be required in connection with this response, the Commissioner is hereby authorized to charge Deposit Account Number 02-4377. A duplicate of this page is enclosed.

Respectfully submitted,



Lisa B. Kole  
PTO Reg. No. 35,225

Attorney for Applicants  
(212) 408-2500

Baker Botts LLP  
30 Rockefeller Plaza  
New York, NY 10112

ASSIGNMENT

WHEREAS, WE, SHANTA M. MODAK and LESTER SAMPATH, both citizens of the United States, residing in Bergen County, State of New Jersey, and Rockland County, State of New York, respectively, whose post office addresses are 184 Howland Avenue, River Edge, New Jersey, 07661, and 7 Lawrence Street, Nyack, New York 10960, respectively, have made an invention entitled "TRICLOSAN AND SILVER COMPOUND CONTAINING MEDICAL DEVICES" as set forth and described in application for Letters Patent of the United States, Serial No. 09/777,121, filed February 5, 2001; and

WHEREAS, THE TRUSTEES OF COLUMBIA UNIVERSITY IN THE CITY OF NEW YORK (hereinafter "COLUMBIA"), having its principal place of business at 116th Street & Broadway, New York, New York 10027, is desirous of acquiring the whole right, title and interest in and to said Letters Patent and any continuations, divisions, extensions, substitutions, reissues and reexaminations thereof;

NOW, THEREFORE, TO ALL WHOM IT MAY CONCERN, BE IT KNOWN, that WE, the said SHANTA M. MODAK and LESTER SAMPATH, for and in consideration of the sum of One Dollar (\$1.00), lawful money of the United States, to us in hand paid by said COLUMBIA, and other valuable considerations unto us moving from said COLUMBIA, at or before the ensealing and delivery of these presents, the receipt of which is hereby acknowledged, have sold, assigned, transferred and conveyed and by these presents do sell, assign, transfer and convey, unto said COLUMBIA, its successors and assigns, the entire right, title and interest in and to the said invention entitled "TRICLOSAN AND SILVER COMPOUND CONTAINING MEDICAL DEVICES" as set forth and described in application for Letters Patent of the United States, Serial No. 09/777,121, filed February 5, 2001, and any and all improvements thereon, and in and to said application and any division, continuation or continuation-in-part thereof, and in and to any Letters Patent of the United States which may be issued on any of said applications, and any reissues thereof, and in and to any and all applications for Letters Patent filed in foreign countries for said invention or improvements including all priority rights, and any and all Letters Patent which may be granted in foreign countries therefor, TO HAVE AND TO HOLD THE SAME to the full end of the term or terms for which any and all said Letters Patent may be granted;

AND WE, the said SHANTA M. MODAK and LESTER SAMPATH, do hereby authorize and request the Commissioner of Patents and Trademarks to issue the said Letters Patent of the United States to said COLUMBIA, as the assignee of the entire right, title and interest in and to the same, for the sole use and benefit of said COLUMBIA, its successors and assigns;

AND WE, the said SHANTA M. MODAK and LESTER SAMPATH, for the considerations aforesaid, do hereby covenant and agree to and with said COLUMBIA, its successors and assigns, that we have the full power to make this assignment, and that the rights assigned are not encumbered by any grant, license or right heretofore given, and that we, our executors or administrators, shall and will do all lawful acts and things and make, execute and deliver without further compensation, any and all other instruments in writing, further applications, papers, affidavits, powers of attorney, assignments, and other documents which, in the opinion of counsel for said COLUMBIA, its successors and assigns, may be required or necessary more effectively to secure to and vest in said COLUMBIA, its successors and assigns, the entire right, title and interest in and to said invention and improvements, applications, Letters Patent, rights, titles, benefits, privileges, and advantages hereby sold, assigned, transferred and conveyed, and that we will sign any applications for reissue which may be desired by the owner of the patent or patents which may be issued for the said invention or improvements.

IN WITNESS WHEREOF, WE, the said SHANTA M. MODAK and LESTER SAMPATH, have hereunto set our hands and seals on the date below written.



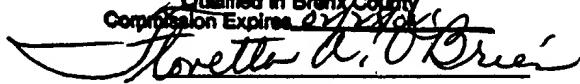
SHANTA A. MODAK

STATE OF NEW YORK )  
: ss.:  
COUNTY OF NEW YORK

BE IT KNOWN, that on this 24<sup>th</sup> day of May, 2001, before me personally came SHANTA M. MODAK, to me known and known to me to be the person mentioned in and who executed the foregoing assignment, and she acknowledged to me that she executed the same as her free act and deed for the use and purposes therein mentioned.

FLORETTA A. O'BRIEN  
Notary Public, State of New York  
No. 03-4619838

Qualified in Bronx County  
Commission Expires 07/31/04

  
Floretta A. O'Brien  
Notary Public

A32359

**A S S I G N M E N T**

WHEREAS, WE, SHANTA M. MODAK and LESTER SAMPATH, both citizens of the United States, residing in Bergen County, State of New Jersey, and Rockland County, State of New York, respectively, whose post office addresses are 184 Howland Avenue, River Edge, New Jersey, 07661, and 7 Lawrence Street, Nyack, New York 10960, respectively, have made an invention entitled "TRICLOSAN AND SILVER COMPOUND CONTAINING MEDICAL DEVICES" as set forth and described in Letters Patent of the United States, U.S. Patent No. 6,224,579, filed March 31, 1999, issued May 1, 2001; and

WHEREAS, THE TRUSTEES OF COLUMBIA UNIVERSITY IN THE CITY OF NEW YORK (hereinafter "COLUMBIA"), having its principal place of business at 116th Street & Broadway, New York, New York 10027, is desirous of acquiring the whole right, title and interest in and to said Letters Patent and any continuations, divisions, extensions, substitutions, reissues and reexaminations thereof;

NOW, THEREFORE, TO ALL WHOM IT MAY CONCERN, BE IT KNOWN, that WE, the said SHANTA M. MODAK and LESTER SAMPATH, for and in consideration of the sum of One Dollar (\$1.00), lawful money of the United States, to us in hand paid by said COLUMBIA, and other valuable considerations unto us moving from said COLUMBIA, at or before the ensealing and delivery of these presents, the receipt of which is hereby acknowledged, have sold, assigned, transferred and conveyed and by these presents do sell, assign, transfer and convey, unto said COLUMBIA, its successors and assigns, the entire right, title and interest in and to the said invention entitled "TRICLOSAN AND SILVER COMPOUND CONTAINING MEDICAL DEVICES" as set forth and described in Letters Patent of the United States, U.S. Patent No. 6,224,579, filed March 31, 1999, issued May 1, 2001, and any and all improvements thereon, and in and to said application and any division, continuation or continuation-in-part thereof, and in and to any Letters Patent of the United States which may be issued on any of said applications, and any reissues thereof, and in and to any and all applications for Letters Patent filed in foreign countries for said invention or improvements including all priority rights, and any and all Letters Patent which may be granted in foreign countries therefor, TO HAVE AND TO HOLD THE SAME to the full end of the term or terms for which any and all said Letters Patent may be granted;

AND WE, the said SHANTA M. MODAK and LESTER SAMPATH, do hereby authorize and request the Commissioner of Patents and Trademarks to issue the said Letters Patent of the United States to said COLUMBIA, as the assignee of the entire right, title and interest in and to the same, for the sole use and benefit of said COLUMBIA, its successors and assigns;

A32359

AND WE, the said SHANTA M. MODAK and LESTER SAMPATH, for the considerations aforesaid, do hereby covenant and agree to and with said COLUMBIA, its successors and assigns, that we have the full power to make this assignment, and that the rights assigned are not encumbered by any grant, license or right heretofore given, and that we, our executors or administrators, shall and will do all lawful acts and things and make, execute and deliver without further compensation, any and all other instruments in writing, further applications, papers, affidavits, powers of attorney, assignments, and other documents which, in the opinion of counsel for said COLUMBIA, its successors and assigns, may be required or necessary more effectively to secure to and vest in said COLUMBIA, its successors and assigns, the entire right, title and interest in and to said invention and improvements, applications, Letters Patent, rights, titles, benefits, privileges, and advantages hereby sold, assigned, transferred and conveyed, and that we will sign any applications for reissue which may be desired by the owner of the patent or patents which may be issued for the said invention or improvements.

Subscribed and executed at Palghat, INDIA  
(Place)

on 7/12/04  
(Date)

Shanta Modak  
SHANTA MODAK

Witness:

Sidharth Nayar  
(Signature)

SIDHARTH NAYAR  
(Print Name)

July 12, 2004  
(Date)

Witness:

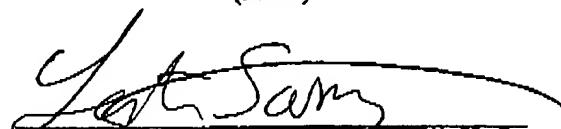
M. C. Nayar  
(Signature)

M. C. NAYAR  
(Print Name)

July 12, 2004  
(Date)

A32359

Subscribed and executed at 7 Lawrence St., Nyack NY 10960  
(Place)  
on 7/14/04  
(Date)

  
LESTER SAMPATH

Witness: Adam Korsin  
(Signature)

Adam Korsin  
(Print Name)

7/14/04  
(Date)

Witness: Christy Sampath  
(Signature)

Christy Sampath  
(Print Name)

7/14/04  
(Date)



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231



JULY 17, 2004

PTAS

\*700099404A\*

BAKER BOTTS L.L.P.  
30 ROCKEFELLER PLAZA  
44 FL.  
NEW YORK, NY 10112

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 07/15/2004

REEL/FRAME: 014852/0785  
NUMBER OF PAGES: 5

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:  
MODAK, SHANTA M.

DOC DATE: 07/12/2004

ASSIGNOR:  
SAMPATH, LESTER

DOC DATE: 07/14/2004

ASSIGNEE:  
TRUSTEES OF COLUMBIA UNIVERSITY IN  
THE CITY OF NEW YORK, THE  
116TH STREET & BROADWAY  
NEW YORK, NEW YORK 10027

SERIAL NUMBER: 09281872

FILING DATE: 03/31/1999

PATENT NUMBER: 6224579

ISSUE DATE: 05/01/2001

TITLE: TRICLOSAN AND SILVER COMPOUND CONTAINING MEDICAL DEVICES

MARGARET LASALLE, PARALEGAL  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

AUG 23 2004

07/15/2004  
00099404

FILE NO. A32359 070050.0995

RECORDATION FORM COVER SHEET  
PATENTS ONLYU.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Offi

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

## 1. Name of conveying party(ies):

Shanta M. Modak, Lester Sampath

Additional name(s) of conveying party(ies) attached?

 Yes No

## 2. Name and address of receiving party(ies)

Name: The Trustees of Columbia University in the City  
of New York

Address: 116th Street &amp; Broadway

City: New York State: NY Zip: 10027

Additional name(s) and address(es) attached? Country:

 Yes  No

Execution Date: July 12, 2004; July 14, 2004

## 4. Application number(s) or patent number(s) 6,224,579

If this document is being filed together with a new application, the execution date of the application is

A. Patent Application No.(s)

B. Patent No.(s)

## Additional numbers attached?

 Yes No5. Name and address of party to whom correspondence  
concerning document should be mailed:

Name:

BAKER BOTTS L.L.P.  
30 Rockefeller Plaza - 44 Fl.  
New York, NY 10112

## 6. Total number of applications and patents involved: 1

## 7. Total fee (37 CFR 3.41): \$ 40

 Enclosed Authorized to be charged to deposit account8. Deposit account number:  
02-4377 (Charge any additional fees to this account)  
(Attach duplicate copy of this page if paying by deposit  
account)

## DO NOT USE THIS SPACE

## 9. Statement and signature

*To the best of my knowledge and belief, the foregoing instrumentation is true and correct and any attached copy is a true copy of the original document.*

Lisa B. Kole

Name of Person Signing

Signature

July 15, 2004

Date

Page 1 of 2

Total number of pages including cover sheet, attachments and document:

62-24579

CH \$40.00 024377

AUG 23 2004

FILE NO. A32359 070050.0995

RECORDATION FORM COVER SHEET  
PATENTS ONLYU.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Off

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

10. Additional Names of assigning party(ies):

10a. Additional Names of receiving party(ies):

11. Application number(s) or registration number(s):

A. Patent Application No.(s)

B. Patent Registration No.(s)

Page 2 of 2Do not detach this portion  
Mail documents to be recorded with required cover sheet information to:

Commissioner of Patents and Trademarks  
Box Assignments  
Alexandria, VA 22313-1450